

REMARKS

By this Amendment, Applicant amends claims 8 and 14 for clarity. Claims 8-17 are pending in this application.

In the Final Office Action,<sup>1</sup> the Examiner rejected claims 8-11 and 13 under 35 U.S.C. § 102(b) as anticipated by Iijima (U.S. Patent No. 5365,045); rejected claims 12 and 14 under 35 U.S.C. § 103(a) as obvious over Iijima in view of *Applied Cryptography* by Schneier; and rejected claims 15-17 under 35 U.S.C. § 103(a) as obvious over Iijima in view of Schneier, and further in view of Grimonprez et al. (U.S. Patent No. 5,473,690).

Applicant respectfully traverses the Examiner's rejection of claims 8-11 and 13 under 35 U.S.C. § 102(b) as anticipated by Iijima. To properly anticipate Applicant's claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8<sup>th</sup> ed., Aug. 2001), quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8<sup>th</sup> ed. 2001), p. 2100-69.

Claim 8 recites a portable electronic device with a security function, containing an application program, including, among other things, "means for storing validity data

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

indicating whether the security function is valid in a nonvolatile memory.” Iijima does not disclose at least these features of claim 8.

Instead, Iijima, at column 12, lines 40-43, teaches that “when an issuer of an IC card check a memory of the card, optional data is written and a verification therefore is performed.” An example of “optional data,” according to Iijima, is “increment data starting from ‘00.’” See col. 1, 32-37. The optional data disclosed in Iijima, however, does not constitute “validity data indicating whether the security function is valid,” as recited in claim 8. Accordingly, Iijima does not disclose “means for storing validity data indicating whether the security function is valid in a nonvolatile memory,” and certainly fails to teach storing such “data” as further recited in claim 8.

Moreover, to the extent “verification” in Iijima corresponds to the claimed security function, which Applicant does not agree, Iijima still fails to teach “storing validity data indicating whether the security function is valid,” as recited in claim 8. Iijima, therefore, fails to teach the claimed “means for storing validity data indicating whether the security function is valid in a nonvolatile memory,” as recited in claim 8. For at least this reason, claim 8 is allowable over Iijima and, accordingly, Applicant requests the Examiner to withdraw the rejection.

Dependent claims 9-11 and 13 depend from allowable claim 8. For at least the same reasons discussed above, dependent claims 9-11 and 13 are also allowable over Iijima. Applicant therefore requests the Examiner to withdraw the rejection of claims 9-11 and 13.

Applicant respectfully traverses the rejection of claims 12 and 14 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier. To establish a proper *prima*

*facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claims 12 and 14 depend indirectly from allowable claim 8. While Schneier discloses protocols for cryptography, Schneier does not make up for the above noted shortcomings of Iijima. In particular, Schneier also does not disclose or suggest "means for storing validity data indicating whether the security function is valid in a nonvolatile memory," as recited in claim 8. Accordingly, Iijima and Schneier, whether taken alone or in combination, do not disclose or suggest claim 8. Claims 12 and 14 are thus allowable at least due to their dependence from claim 8.

Applicant respectfully traverses the rejection of claims 3, 6, and 15-17 under 35 U.S.C. § 103(a) as unpatentable over Iijima in view of Schneier, and in further view of Grimonprez. Claims 15-17 depend indirectly from allowable claim 8. As discussed above, Iijima and Schneier do not disclose or suggest each and every element of claim 8. Grimonprez, which discloses loading a plurality of applications into a memory card, also does not overcome the above-described shortcomings of Iijima and Schneier. In

particular, Grimonprez does not disclose or suggest "means for storing validity data indicating whether the security function is valid in a nonvolatile memory," as recited in claim 8. Accordingly, Iijima, Schneier, and Grimonprez, taken alone or in combination, do not disclose or suggest claim 8. Claims 15-17 are therefore allowable at least due to their dependence from claim 8.

**CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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